

**REMARKS CONCERNING THE STATUS OF THE CLAIMS WITHOUT
FURTHER AMENDMENTS**

The present RCE is being filed, and the claims are not being further amended as upon reflection, it has been determined that the filing of a Terminal Disclaimer was unnecessary. The purpose for filing this RCE is to remove and withdraw any Terminal Disclaimer. The rejection under Obviousness-Type Double Patenting is argued on its merits below and is traversed.

SUMMARY OF THE REJECTIONS

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Rejections Under 35 USC 112, Second Paragraph

Claims 1-19 have been rejected under 35 USC 112, second paragraph. The same limitation in claims 1, 4 and 15 is asserted to lack clarity. That phrase is:

“...resolving the bet with respect to c)...”

Rejections Under The Judicially Created Doctrine of Double Patenting

All claims have been rejected under a purported Judicially Created Doctrine of Double Patenting over the claims of U.S. Patent No. 6,179,711. It is believed that the rejection should be obviousness-type double patent as the basis for Double Patenting is not judicially created, but has been found by the courts to reside in 35 USC 101.

Additionally, a Terminal Disclaimer is effective against Obviousness-Type Double patenting, but is not effective against Double Patenting.

Rejections Under 35 USC 103(a)

Claims 1-30 have been rejected under 35 USC 103(a) as unpatentable over Netley (US Patent No. 5,868,618) in view of Ornstein (US Patent No. 5,570,885). It is asserted that Netley teaches every limitation of the claims except for “paying for a parlay or consecutive winnings on hands.” It is asserted that as Ornstein teaches a wagering game allowing a player to win multiple bets for consecutive winning hands, it would be obvious to modify the game of Netley to allow for the enhanced play taught by Ornstein.

RESPONSE TO THE REJECTIONS

Rejection Under 35 U.S.C. 112, Second Paragraph

Although a single term was referred to in the statement of the rejection in Paragraph 1 on Page 2 of the Office Action mailed May 21, 2002, that term is highly excerpted from the actual text. The language (with amendments presently added) actually reads:

“...resolving the at least one bet with respect to whether a) the first hand exceeds a minimum rank in the payout table; b) the second hand exceeds a minimum rank in the payout table; and c) both the first hand of cards and the second hand of cards [exceeds] exceed a minimum in the payout table.”

Read in its entirety, the language conveys a vastly different concept than the meaning considered in the rejection, even though the language is clear on its face.

Wagers (bets) in the field of gaming are resolved. That is, wins are paid, losses are withdrawn by the house, and ‘pushes’ (ties) are left in place. This is the clear meaning of the term “resolving” as used in the art and as used and explained in the specification. As noted in the claims and in this particular language, at least one bet (wager) is placed, and the final sequence of steps in the process is “resolving the at least one bet.” The important aspects of this process that has not been appreciated in the interpretation of the claim are the facts that:

- 1) There must be two consecutive hands in each play of the game;
- 2) There must be three distinct events that must be resolved in the play of two hands.

The three distinct events that must be resolved according to the recitations of the claims are summarized as follows:

- a) Exceeding of a minimum rank by the first hand (according to a payout table)
- b) Exceeding of a minimum rank by the second hand rank (according to a payout table), and
- c) Exceeding of a minimum rank by both the first and second hands (according to a payout table)

This resolution does not constitute a parlay or a bonus play. A parlay is where an amount that is initially put at risk and the amount won in a first event is carried into play (and usually placed at risk) in a second play. A bonus is where the occurrence of a first event (usually an elevated level of win) is required to get to a play where an additional (and often larger) payout may be obtained. In a bonus, the won amount may or may not be placed at risk. Each of those plays (parlay and bonus) is distinct from the play recited in the claims.

In the play of the present game, after the initial at least one bet has been made, there are two consecutive hands dealt. Both hands are dealt and both hands are played, irrespective of the events that occur in the other hand. This is therefore clearly neither a parlay (which requires winning amounts to be carried forth in a subsequent play) or a bonus (as there is no 'win' or special event needed in the first hand to enable play in the second hand).

In the play of the present game, an award is paid for 1) minimum ranks in the first hand, 2) minimum ranks in the second hand, and 3) minimum ranks in both hands. These are three distinct payments that are available in the play of two required hands in a single game. This is significantly different from what is taught in the art. The play of the game as represented by the claims is also abundantly clear.

The claim clearly recites that the bet is resolved:

with respect to whether

- a) the first hand exceeds a minimum rank in the payout table;
- b) the second hand exceeds a minimum rank in the payout table;

and

- c) both the first hand of cards and the second hand of cards exceed
a minimum in the payout table

The claim clearly requires that all three events be resolved with regard to the at least one wager. The three events are not a Markush Group, or alternatives, but are three events for which resolution of the at least one bet must be made in the play of the game. The claim is in compliance with 35 USC 112, second paragraph.

(Obviousness-Type) Double Patenting

Claim 1 of U.S. Patent No. 6,179,711 is:

1. A method of scoring a video wagering game, the game comprising at least a first and second segment, the method comprising the steps of:
- placing a wager to participate in a video wagering game;
 - playing the first segment of the video wagering game;
 - continuing play of the first segment until at least one predetermined condition has been met;**
 - assigning a payout based on at least one winning outcome of the first segment;
 - playing the second segment of the video wagering game when the at least one predetermined condition has been met;**
 - wherein said payout of the first segment is enhanced by a factor determined by an outcome in the second segment, and wherein the factor is at least one;**
 - multiplying the payout of the first segment by the factor determined in the second segment; and**
 - paying the enhanced payout to the player.

This rejection is not understood, as the games recited in the present claims are quite distinct from the elements of the method recited in the claims of U.S. Patent No. 6,179,711. Significant elements of the Patent claim that are not present in the play of the present method (in any claims) are highlighted.

The highlighted portions are not present in the recited method because:

- continuing play of the first segment until at least one predetermined condition has been met;**
- 1) There is no predetermined condition that is a condition precedent for any additional play, as recited in the Patent claim.
- playing the second segment of the video wagering game when the at least one predetermined condition has been met;**
- 2) The second hand is always dealt and is always played in the presently claimed method. There is no condition precedent of "playing...when the at least predetermined condition has been met." The second set of symbols or the second game is always played.
- wherein said payout of the first segment is enhanced by a factor determined by an outcome in the second segment, and wherein the factor is at least one;**
- 3) The second game does not determine factors. The second game (e.g., the second set of symbols or second hand) is independently awarded on the basis of its rank according to the pay table. No factor is determined.
- multiplying the payout of the first segment by the factor determined in the second segment;**

Same as
13/5/19/5/2

4) There is no multiplication of the first award by a factor determined in the second game event. The first payout is not multiplied. That amount is paid out (resolved in step a) by itself. The other events are separately paid out.

It is absolutely clear that the two processes (of the patented claims and the present claims) do not overlap. The present claims could not have been recited in the Patent, as the present claims are a distinct invention not even within the generic scope of the claims of the Patent, and the subject matter of the present process was not disclosed in the specification of the patent.

The rejection for Double Patenting or Obviousness-Type Double Patenting is completely in error.

Rejections Under 35 USC 103(a)

Claims 1-19 and 22-37 have been rejected under 35 USC 103(a) as unpatentable over Williams in view of Ornstein (US Patent No. 5,570,885). It is asserted that Williams teaches every limitation of the claims except for "resolving a bet with respect when both first and second set of symbols exceed a minimum rank in the pay table."

It is asserted that as Ornstein teaches a method of playing a game where a payoff is made for consecutive winnings, one of ordinary skill in the art would have made the Williams game more attractive for players by making an additional payoff for winning two or more plays consecutively. It is therefore asserted that it would have been obvious to modify the game of Williams to allow for the enhanced play taught by Ornstein.

Claim 20 has been finally rejected under 35 USC 103(a) as unpatentable over Netley in View of Ornstein. It is asserted that Netley shows every element of the claimed invention except for "paying for a parlay or consecutive winnings on hands." It then is asserted that as Ornstein teaches a wagering game allowing a player to win multiple bets for consecutive winning hands, it would be obvious to modify the game of Netley to allow for the enhanced play taught by Ornstein.

See
15/1520128

Rejection of Claims 1-19 and 22-37 Under 35 USC 103(a) As Unpatentable Over Williams In View of Ornstein

Claims 1, 2 and 20-21 shall stand or fall with the patentability of claim 1 under the issue of obviousness under 35 U.S.C. 103(a)

This rejection is in error, even if the references are combined in the manner proposed by the Examiner. Each of these claims contains essentially the same limitations:

“...placing at least one bet...” or “...placing at least a one part bet...”; and
“...playing a second wagering game segment whose outcome is based at least in part on chance without placing further wagers in addition to the wager comprising at least one part...” (or the least one bet).

16/5-24
The significance of this difference is that Ornstein requires that a second bet be placed **after the play of the first hand and before play of the second hand, so that the limitation of playing a second wagering game segment...without further placing wagers in addition to the at least one part IS NOT TAUGHT BY WILLIAMS IN VIEW OF ORNSTEIN.** Note for example, column 4, lines 26-32 where Ornstein states:

“After the play of the first hand and assuming that the player making the bets in Fig. 3a has a winning hand, a streak chip S, which is under the control of the dealer, is placed in region C2 by the dealer. The player’s original bet is paid off and **the player then makes another original bet preparatory to the initiation of the second play,** as shown in Fig 3b.”

(emphasis added)

Additionally, the play of the game remains the same (including originating wagers in each game) with each variety of game played, as stated by Ornstein on column 5, lines 51-56; and column 6, lines 25-32. In every description of the games, the play of the underlying game remains the same for the same game, which includes the originating bet in the game, whether the first game or the second game.

Ornstein therefore clearly teaches away from the specific limitation that Appellant asserts for patentability with respect to the limitations in the independent claims recited above, the requirement that no additional bet be made. As Ornstein specifically teaches

that a second bet is to be made prior to play of the second game, the reference, either alone or in combination with Williams, does not teach the actual limitations of the claims.

12/5-24
Additionally, Ornstein does not maintain a sense of the relative rank of hands, and in fact never mentions rank as a basis for payment. The only mention of Poker is incidental (column 6, lines 32-37) and never discusses play against a pay table. This is an essential element of play in the present game and is recited in the claims, and is the basis for payment of the parlay event. The parlay is not paid for merely winning, but for both hands exceeding a minimum rank against a payable. The very nature of the game recited in the claims on Appeal requires that both hands remain displayed on the table at the conclusion of the two games (so that both hands may be compared to respective pay tables and the combined hands be compared to a payable), while the games as described by Ornstein are generally played one hand at a time and the table cleared before beginning the second game. Additionally, none of the games described in detail by Ornstein (baccarat, craps and roulette) have anything akin to ranks and do not mention pay tables. The brief mention of poker, without reference to ranks and play against a pay table renders that incidental remark insignificant as a teaching to grossly modify the play of Williams and the play of Ornstein.

There is no reasoned basis of how or why the play of those games should be modified to become the games recited in the claims. The substantive limitations of the elements of the game recited in the claims are not taught by either reference. It is impossible to create the game recited in the claims when there is no basis for finding those individual parts in the teachings of the references.

There is no basis for finding the use of only a single wagering step in the teachings of the references when there are three bet resolution considerations. There is no basis for finding that there should be three bet resolutions on two hands considered at the same time. The invention as a whole is not obvious from the teachings of the references, alone or in combination.

The rejection of claims 1-19 and 22-37 as unpatentable Williams in view of Ornstein is therefore clearly in error.

Claim 3 shall stand or fall alone under the issue of obviousness under 35 U.S.C. 103(a).
This claim provides different the minimum ranks of the first and second hands
determining the payout amount.

As noted above, the combination of references fails to teach even the consideration of ranks and pay tables for those ranks in the determination of winning events in the play of the underlying consecutive games of Ornstein. It is clearly not obvious to use different paytables for payments on ranks in contemporaneously resolved games according to these claims.

Claims 4-11 shall stand or fall with the patentability of claim 4. These claims distinguish from the limits of claim 1 at least for the reason of using decks of cards in the provision of symbols.

These claims are further distinguishable according to the issues of claim 1 by the fact that all games according to these claims must be played with playing cards and that ranks must be considered in determining winning events, and that three wager resolutions are made on the basis of the rank of two hands. These claims are patentable for all of the reasons that claims 1 and 2 were patentable and for the further limitation of ranks having to be made with playing card hands.

Claims 12-14 shall stand or fall with the patentability of claim 12. These claims recite that there must be three distinct wagers and apportions each wager to specific elements of play among the two hands of cards.

The combination of Williams in view of Ornstein is not obvious for the reasons that claims 1, 2 and 4-11 are not obvious, and for the reason that three wagers must be made simultaneously as the at least one wager, to which no further wagers may be added. The play of Ornstein and the nature of the games played in the disclosure teach only that two initial wagers are to be placed and that a third wager may be later placed, if the first hand wins and the second wager remains in play. There is no teaching of the obviousness of the sequence of play in these claims from those instructions of the prior art used in the rejection.

Claims 15 and 16 shall stand or fall with the patentability of claim 15 under the issue of obviousness under 35 U.S.C. 103(a). The claims are specific to a video game embodying the rules of the underlying parlay poker game.

Claims 15 and 16 are patentable not only for the same reasons that claims 1 and 2 were argued to be patentable above, but also because the rules of those games are embedded in a video wagering game. Although Ornstein mentions the applicability of his technology to video gaming equipment (column 1, lines 6-10), the nature of play described for those games do not include contemporaneously displayed wins, but rather only consecutively displayed wins. The payouts for placement of the streak chips of Ornstein are independent of any ranks. There are no paytables, but only individual odds on streaks. (Column 2, lines 39-55)

Claims 17 and 18 shall stand or fall with the patentability of claim 17 under the issue of obviousness under 35 U.S.C. 103(a). These claims recite that there must be three distinct wagers and apportions each wager to specific elements of play among the two hands of cards.

Again, as this claim recites that there are three initial wagers, that no further wager may be placed, and that each wager is separately evaluated and then jointly evaluated for wins, there is no teaching of the practice of this limitation in the art used in the rejection.

Claim 19 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim provides a specific pay table for the individual hand play and for the parlay poker play.

There is no showing of this specific payable, and there is no showing of the use of three contemporaneously considered paytables for two hands. There is absolutely no basis for asserting the obviousness of this claim.

Claims 22-25 and 29 shall stand or fall with the patentability of claim 22. This claim broadly claims the use of segments in games as the underlying play events in the parlay game.

These claims are patentable for the same reasons argued with respect to claims 1, 2 and 20-21. These claims also allow for the first and second games to be different games.

Claim 26 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, the use of reel slot games as the underlying games in the parlay event.

There is no disclosure in Ornstein that would allow or teach for the underlying games to be reel slot games.

Claim 27 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, the underlying game requiring that a player's hand beat a dealer's hand.

Even with poker versus a dealer's hand being played, there is no teaching in Williams in view of Ornstein that allows for a single wager to be placed, with no additional wagers allowed for the second segment or the consecutive play segment of this claim.

Claim 28 and 30 shall stand or fall with the patentability of claim 28 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, this claim providing a rule wherein the lowest rank of the two hands determining the award for the parlay wager.

Appellant cannot conceive of how this limitation is to be found in the teachings of the combination of references. There is no rank considered in the winning of hands, there is no comparison made between consecutive hands or their rank, and there is no paytable based upon the rank of hands or the minimum rank of of a pair of hands. There is absolutely no basis for finding that these limitations are obvious or taught by Williams in view of Ornstein.

Claim 31 shall stand or fall by itself under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, the claim providing an alternative description of the play of the game.

This claim is patentable not only for all of the reasons given above for the patentability of claims 1, 2 and 20-21 (except for the requirement of only a single wager placing step), but also for the specificity of these claims with respect to requiring different paytables for comparison of the first set of symbols, the second set of symbols, and the rank of both hands with a third payable. There is absolutely no basis from the teachings of the references of this concept.

Claims 32 and 36 shall stand or fall with the patentability of claim 32 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, wherein play is limited to a single bet.

This set of claims adds the requirement for the at least one wager to be only a single bet (which may be in component parts), excluding subsequent wagers.

Claims 33 and 34 shall stand or fall with the patentability of claim 33 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, wherein the payout tables for the first hand and the second hand are the same.

In addition to the requirements made with respect to the patentability of claim 31 where paytables are consulted for the first and second set of symbols and then a third table for comparison of the symbol sets, this claim requires that the first and second tables are the same. There is no basis for consideration of this limitation in the objective teachings of Williams in view of Ornstein. There can be no obviousness of this claim from the teachings of the references.

Claims 35 and 37 shall stand or fall with the patentability of claim 35 under the issues of 35 U.S.C. 103(a). This claim recites specific limitations that distinguish it from all earlier claims, wherein the payout tables for the first hand and the second hand are different.

In addition to the requirements made with respect to the patentability of claim 31 where paytables are consulted for the first and second set of symbols and then a third table for comparison of the symbol sets, this claim requires that the first and second tables are different. There is no basis for consideration of this limitation in the objective teachings of Williams in view of Ornstein. There can be no obviousness of this claim from the teachings of the references.

Rejection of Claim 20 Under 35 USC 103(a) Over Netley in View of Ornstein

It is asserted that Netley shows every element of the claimed invention except for “paying for a parlay or consecutive winnings on hands.” It then is asserted that as Ornstein teaches a wagering game allowing a player to win multiple bets for consecutive winning hands, it would be obvious to modify the game of Netley to allow for the enhanced play taught by Ornstein.

Netley does not show every element of the claims (the claim that is believed to be the broadest claim of this application, Claim 1, will be examined in this light), except for the parlay wager. In fact, Netley shows a traditional parlay type wager that is excluded from play of the present game. A side-by-side comparison of Netley and the claimed play (with comments) would be helpful in detailing the differences.

Claim 1 of Application	Netley Disclosure	COMMENTS
1. A method of playing a wagering game with at least two consecutive plays comprising:	Netley has consecutive plays only after a win in a first hand and an election to wager on a second, bonus-type round.	The preamble requires the underlying game to have at least two consecutive hands. There may not be only an optional or bonus play.
Placing at least one bet;	At least one bet is placed.	Same step
receiving at least one first set of symbols from which a rank may be determined in reading the symbols;	Netley receives a hand of cards from which a rank may be determined.	Same step
determining the rank of the first set of symbols;	A rank is determined.	Same step
comparing the first set of symbols to a payout table;	A payout table is used to determine an amount of win	Same step
determining whether the rank of the first set of symbols exceeds a minimum rank in the payout table;	A minimum rank on the payout table is determined in comparison with the hand.	Same step
receiving at least a second set of symbols from which a rank may be determined without having placed an additional bet;	Netley provides a second hand only with a “win” in the first hand.	This step is a required, not optional step in the invention. Even with a win in Netley, this is optional. Without a win, there is no second hand.
determining the rank of the second set of symbols;	A rank is determined in the second hand.	Same Step
comparing the rank of the second set of symbols to a	A payout table is used to determine an amount of win	

payout table;		
determining whether the rank of said second set of symbols exceeds a minimum rank in the payout table;	A minimum rank on the payout table is determined in comparison with the hand.	
resolving the at least one bet with respect to whether a) the first set of symbols exceeds a minimum rank in the payout table;	The first bet of Netley is resolved with respect to the first set of symbols and the first pay table.	It is important to note that a distinct bet is made by Netley for the first hand and second hand. If the player wins the first hand, he can "either accept payment...or....wager the amount on a second tier poker hand. Col. 1, lines 45-52.
b) the second set of symbols exceeds a minimum rank in the payout table;	The distinctly separate second bet of Netley is resolved with regard to the second set of symbols.	The claims of the invention require that the at least first bet is resolved with regard to the second set of symbols.
and c) <u>both the</u> first set of symbols and the second set of symbols exceed a minimum in the payout table.	There is no third resolution in Netley. There are at most two resolutions on two hands. Payout for the first hand and payout for the second hand.	This concept of three payouts is absent from Netley. Netley is literally no more than a true parlay series of play, with an election of the amount to parlay.

Ornstein does not cure the deficiencies of Netley. Ornstein merely describes a side bet game on the occurrence of consecutive wins in a base game, such as the game of blackjack. It does not require the player to participate in a second game without having placed an additional bet, and it does not provide an additional bonus payout for wins on both base games.

The rejection of claims under 35 USC 103(a) over Netley in view of Ornstein must fail for at least that reason.

CONCLUSION

Applicant has shown that all rejections of record are in error and should be withdrawn.

Applicants assume the application is now in proper order and in condition for examination. If the Examiner finds that certain issues may remain in this application, the Examiner is courteously invited to call the attorney of record, Mark A. Litman at 952.832.9090 to discuss those remaining issues.

Respectfully submitted,

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By: 

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on February 6, 2004.

Mark A. Litman
Name


Signature